

PTO/SB/21 (09-04)

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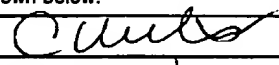
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/332,264	
	Filing Date	June 11, 1999	
	First Named Inventor	Wood	
	Art Unit	2633	
	Examiner Name	Shi K. Li	
Total Number of Pages in This Submission	5	Attorney Docket Number	Wood 27

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Date	2/7/05	Reg. No.	39,414

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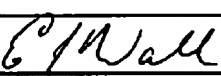
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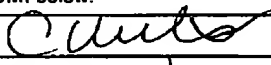
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Appellant still upholds that the mere popularity of a given feature cannot be used to sustain the rejection.

As the Examiner noted on page 7 of his Answer, "The Examiner recognizes that obvious can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)." Additionally, and as previously offered by the Examiner, "popularity of Ethernet is well known in the art and considered as knowledge generally available to one of ordinary skill in the art". Additionally, the Examiner offers "to prove that popularity of Ethernet is in fact well known in the art, the Examiner attaches Frazier (H. Frazier, "The 802.3z Gigabit Ethernet Standard", IEEE Network, May/June 1998) where it describes Ethernet as "the world's most popular" standard in the first sentence. Therefore, the popularity of Ethernet is level of knowledge of one of ordinary skill in the art, and the combination of Bohn et al. and Lewin et al. is well motivated and obvious."

In response, Appellant has at no point in the prosecution denied the existence of Ethernet or attempted to rebut the Examiner's support as to the level of popularity and extent of use at the current time. However, such widespread existence or use does not guarantee applicability of such technology to all situations (and in this particular case provide suggestion to be combined with the system of Bohn to arrive at the subject invention). That is, widespread usage (popularity) in and of itself is not a suggestion or motivation to combine or modify the prior art to arrive at the subject invention. There was no apparent disadvantage to the collisionless system of Bohn; therefore, there is no motivation to combine such system with Ethernet based on the nature of Appellant's problem (i.e., Ethernet fails as a communication protocol as the physical system increases, see Appellant's Background of the Specification, Page 5, lines 1-5). Hence, the popularity of a possible solution is irrelevant.

The Examiner then offers that popularity of a particular feature raises a compatibility issue. Specifically, the Examiner offers U.S. Patent No. 6,654,374 to Fawaz to show "a system in accordance with the invention is not only high performance,

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but also economical, simple, and flexible, while remaining compatible with much of the hardware and software already in place, particularly hardware and software for routers and Ethernet interfaces". As such, the Examiner concludes that one of ordinary skill in the art would have been motivated to incorporate a popular feature because it makes an apparatus compatible with existing equipment. In reply, Appellant offers that this line of reasoning may be applicable if compatibility with existing equipment were a criteria, objective or necessary consideration of the cited references and particularly in Bohn. Specifically, Bohn's system was designed to operate in and of itself to achieve its objectives and such was explained at Page 10-12 of Appellant's Appeal Brief. As the reference did not teach or suggest any alternate designs or offer the ability to be integrated into a non-optically-based system, the desirability of compatibility with existing equipment is not an aspect of the prior art that is acknowledged as missing by Bohn and hence needs to be addressed. Accordingly, it is indicated that there is absolutely no desirability of combining the Ethernet of Lewin in Bohn's system because Bohn lacks the desirability to have its system altered in such a manner.

Conclusion

For the reasons advanced above, Appellants respectfully urge that the rejection of claims 1, 2, 3, 4, and 7-15 as being unpatentable under 35 U.S.C. §103 are improper. Reversal of the rejections in this appeal is respectfully requested. It is believed no fee is due. However, in the event a fee is due, kindly charge that fee to Deposit Account No. 20-0782.

Respectfully submitted,



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